



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,025	01/17/2002	Katsuyuki Saito	P/16-302 DIV	5548

2352 7590 07/13/2006

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

SENF, BEHROOZ M

ART UNIT PAPER NUMBER

2621

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/047,025	Applicant(s) SAITO ET AL.	
	Examiner Behrooz Senfi	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 21 – 32 are objected to because of the following: Abbreviation "PC" should be identified in first occurrence. Appropriate correction is required.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)., *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)., *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 21 - 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 30 of copending Application No. 10/046,830 (US 2002/0196334 A1).

This is a provisional obviousness-type double patenting rejection.

3. Claims 21 - 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 30 of copending Application No. 10/046,830 (US 2002/0196334 A1). Although the conflicting claims are not identical they are not patentably distinct from each other because claims

Art Unit: 2621

21 - 32 of the instant application is broader than the claims 1 – 30 of copending Application No. 10/046,830 (US 2002/0196334 A1).

It is noted that, claims 1 – 30 of copending Application No. 10/046,830 (US 2002/0196334 A1), claims means for projecting an object image produce by endoscope and claims 21 - 32 of the instant application, claims device for projecting an object image produce by endoscope, which is broader than claims 1 – 30 of copending Application No. 10/046,830 (US 2002/0196334 A1).

It is noted that allowing claims 21 - 32 of the instant application would unduly extend the timewise monopoly of the patent.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 21 - 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 30 of copending Application No. 10/036,408.

This is a provisional obviousness-type double patenting rejection.

5. Claims 21 - 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 30 of copending Application No. 10/036,408. Although the conflicting claims are not identical they are not patentably distinct from each other because claims 21 - 32 of the instant application is broader than the claims 1 – 30 of copending Application No. 10/036,408.

It is noted that allowing claims 21 - 32 of the instant application would unduly extend the timewise monopoly of the patent.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21 – 22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanno et al (US 4,727,417) in view of Uehara et al (US 5,592,216).

Regarding claim 21, Kanno '417 teaches, an endoscopic imaging system (i.e. fig. 2) comprising: an imaging device for projecting an object image produced by an endoscope (i.e. fig. 2, endoscope 11) a signal processing element for processing a video signal representing the object image projected by the imaging device (i.e. fig. 2, video processor 13, abstract, lines 3 – 5) an image display element for displaying the video signal as an endoscopic image on a monitor (i.e. fig. 2, monitor 23), an image recording element for recording digital still image data relevant to the object image projected by the imaging device (i.e. fig. 5, image recording 116) and a remaining capacity sensing element for sensing a remaining storage capacity (i.e. figs. 5 and 7, component 115, col. 4, lines 65 – 68) and an arithmetic calculation means for calculating a number of remaining recordable images according to the remaining storage capacity sensed by the remaining capacity sensing element (i.e. figs. 5 and 7, col. 3, lines 51 – col. 4, lines 20) and a medium information display element for

Art Unit: 2621

displaying medium information and the number of remaining recordable images, on the monitor or other display device (i.e. fig. 7).

Kanno '417 patent is silent in regards to, PC card serving as a portable recording medium to be detachably attachable to the signal-processing element.

Uehara '216 in the same field teaches the use of PC card serving as a portable recording medium to be detachably attachable to the signal-processing element (i.e. figs. 4 and 5, col. 5, lines 58 – col. 6, lines 5).

In view of the above it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the image recording unit 112 of the Kanno in accordance with the teaching of Uehara by using PC card for recording purpose, for the benefit of minimizing complicated peripheral devices in order to store or record and reproduce image information, as suggested by Uehara (col. 2, lines 60 – 65). Furthermore; it is noted that Uehara is silent in regards to, a connection sensing element for sensing a connection state of the PC card. Examiner takes Official Notice to note that; the concept of, connection sensing element for sensing loading and/or unloading of a memory card (PC card) is well known in the prior art of the record (especially in electronic still video camera and play back), which detects the connection state of the memory. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to implement such teachings for the purpose of detecting the connection state of the memory.

Regarding claim 22, combination of Kanno and Uehara teaches, wherein the

Art Unit: 2621

medium information display element superimposes the medium information on the endoscopic image on the monitor (Kanno, col. 6, lines 35 – 37).

Regarding claims 32, the limitations claimed have been analyzed and rejected with respect to claim 21 above.

8. Claims 23 – 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanno et al (US 4,727,417) in view of Uehara et al (US 5,592,216) further in view of Moronaga et al (US 5,956,084).

Regarding claim 23, combination of Kanno and Uehara teaches, displaying medium information on monitor, as discussed in claim 21 above.

It is noted that, Kanno '417 patent is silent in regards to “a liquid crystal monitor” for displaying medium information independently of the monitor.

Moronaga '084 in the same field teaches the use of “liquid crystal monitor” displaying information independently of the monitor; please see (figs. 1 and 3, liquid crystal display 12).

In view of the above it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the video apparatus of Kanno in accordance with the teaching of Moronaga by using a liquid crystal monitor for the purpose of displaying the information related to the storage device (col. 10, lines 32 – 45).

Regarding claim 24, combination of Kanno, Uehara and Moronaga teaches, wherein the liquid crystal monitor is located on a front panel of a camera control unit including signal processing element (Moronaga, fig. 1, display 12).

Art Unit: 2621

Regarding claim 25, combination of Kanno, Uehara and Moronaga teaches, wherein the medium information display element displays the medium information on the monitor or other display device every time a user records still image data on the PC card or only when the remaining number of images recordable on the PC card becomes a given number (Moronaga, col. 10, lines 32 – 42).

Regarding claim 26, the limitations claimed have been analyzed and rejected with respect to claim 25 above.

9. Claims 27 and 31, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanno et al (US 4,727,417) and Uehara et al (US 5,592,216) and Moronaga et al (US 5,956,084) and further in view of Moriyama (US 5,810,715).

Regarding claim 27, it is noted that Kanno '417 patent is silent in regards to "voice notification element".

However the above subject matter is well known in the prior art of the record as evidenced by, Moriyama '715; see (col. 18, lines 10 – 13).

In view of the above it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the video apparatus of Kanno in accordance with the teaching of Moronaga by using voice notification to notify the user by voice.

Regarding claim 31, the limitations claimed have been analyzed and rejected with respect to claim 27.

Art Unit: 2621

10. Claims 28 - 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanno et al (US 4,727,417) and Uehara et al (US 5,592,216) further in view of Moriyama (US 5,810,715).

Regarding claim 28, it is noted that Kanno '417 patent is silent in regards to "voice notification element".

However the above subject matter is well known in the prior art of the record as evidenced by, Moriyama '715; see (col. 18, lines 10 – 13).

In view of the above it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the video apparatus of Kanno in accordance with the teaching of Moronaga by using voice notification to notify the user by voice.

Regarding claim 29, the limitations claimed have been analyzed and rejected with respect to claim 28 above.

11. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanno et al (US 4,727,417) and Uehara et al (US 5,592,216) further in view of Scott et al (US 6,545,687).

Regarding claim 30, it is noted that combination of Kanno and Uehara is silent in regards to "stretching compressed image data".

Art Unit: 2621

However the above subject matter is well known in the prior art of the record as evidenced by, Scott '687 (fig. 7A, 41, col. 10, lines 21 – 35) where teaches stretching the image to the desired size.

In view of the above it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Kanno's video processing in accordance with the teaching of Scott '687 for the purpose of stretching the image to the predetermined/desired size, as suggested by Scott (col. 10, lines 21 – 35).

Contact

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Behrooz Senfi** whose telephone number is **(571) 272-7339**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mehrdad Dastouri** can be reached on **(571) 272-7418**.

Hand-delivered responses should be brought to Randolph Building, 401 Dulany Street, Alexandria, Va. 22314.

Any inquiry of a general nature or relative to the status of the application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is **(571) 272-6000**,

Or faxed to:

(571) 273-8300

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.M.S.

7/7/2006

Mehrdad Dastouri
MEHRDAD DASTOURI
SUPERVISORY PATENT EXAMINER
TC 2600